PUBLIC PROSECUTOR

v.

ANG POON TEIK

HIGH COURT MALAYA, JOHOR BAHRU
DATO' ABDUL MALIK ISHAK J
[CRIMINAL APPEAL NO: 41-85-1994]
10 OCTOBER 1995

TRADE MARKS: *Trade description - Offering to supply goods with false trade description - Section 3(1)(b) Trade Descriptions Act 1972 - Goods displayed at business premise of defendant - Whether prima facie case made out - Whether defendant deemed to offer or supply goods to members of public - Section 3 of Act - Whether to be read with s. 8 thereof - Trade Descriptions Act 1972 ss. 3(1)(b), 8, 16(1) - Trade Marks Act 1976 s. 19(1).*

CRIMINAL PROCEDURE: *End of prosecution case - Submission - Whether Court to hear submission - Trial Magistrate heard defence Counsel but refused to hear Prosecuting Officer - Whether a serious irregularity - Whether sufficient ground for ordering retrial - Order of acquittal thereof - Whether flawed.*

This was an appeal by the Public Prosecutor against the order of the trial Magistrate acquitting the respondent on a charge under s. 3(1)(b) Trade Descriptions Act 1972 without calling for his defence. By the charge the respondent was alleged to have offered to supply some 792 units of "Lion" brand steel wool to which a false trade description applied, in that, it was meant to pass off as the "Double Axe" brand of steel wool manufactured by one Kilang Kertas Mei Wah.

It was not in dispute that at the material time the respondent was found to have displayed the said 792 units of "Lion" brand steel wool at his business premise. The learned Magistrate nonetheless acquitted the respondent after apparently comparing the picture of the "Lion" and the picture of the "Double Axe", and found them to be dissimilar. The facts also showed that at the end of the prosecution case, for reasons unclear, the learned Magistrate, after hearing the submission of the defence Counsel, had refused to hear the submission of the Prosecuting Officer. Before the learned Judge the questions that arose were (1) whether the refusal to hear the Prosecuting Officer herein constituted a serious irregularity (2) whether on the facts the learned Magistrate had erred in not calling for the defence.

Held:

[1] Although there is no express provision in the Criminal Procedure Code for a submission to be made at the end of the prosecution case, the practice of the Courts has always been to allow defence Counsel to make such a submission if he so desires and to permit the Deputy Public Prosecutor (and hence the Prosecuting Officer) to reply to such submission. On this technical ground alone, in this case, a retrial ought to be ordered.

[2] In construing s. 3(1)(b) of the Trade Descriptions Act, one must not lose sight of the deeming provision in s. 8 of the same Act. Bearing in mind these sections, by exposing the goods in his business premise the way he did, the respondent must be deemed to have offered to supply them to members of the public. Such offer to supply, as it was, constituted the very essence of the charge against the respondent.

[3] In applying the comparison test three rules ought to be adhered to namely (1) the trademarks concerned must be considered as a whole to see whether they caused any mistake, deception or confusion (2) It must also be considered whether the marks suggest the same idea or lead to the goods being referred to by the same name and (3) where words of two trade marks are compared they ought to be judged both by their looks and sound.

[4] In his sketchy and patently inadequate judgment, the learned Magistrate had clearly ignored certain salient facts and features obtaining in this appeal. The "Double Axe" and "Lion" trademarks bore such similarities in colours and designs that the general public, on seeing the trade marks would certainly be deceived into believing that the "Lion" trade mark was in fact that of the "Double Axe" trade mark. In short, the "Lion" trade mark could pass off as the "Double Axe" trademark.

[Appeal allowed. Retrial before another Magistrate ordered.]

Cases referred to:

Public Prosecutor v. Ong Khoon Seng [1982] 1 MLJ 351 ***(foll)***
Khoo Hi Chiang v. Public Prosecutor [1994] 2 CLJ 151; [1994] 1 AMR 6:323 ***(refd)***
Tan Hap @ Tan Hwa Ho & Anor. (both t/a Syarikat Kwong Hock Hin) v. Liang Ann Hock t/a Kim Guan Trading Company [1989] 2 CLJ 500 ***(dist)***
F. Hoffman-La Roche & Company A.G. And Another v. DD SA Pharmaceuticals Limited [1972] RPC ***(cit)***
Balasingham v. Public Prosecutor [1959] 25 MLJ 193 ***(cit)***
Augustine v. Public Prosecutor [1964] 30 MLJ 7 ***(cit)***
Hashim & Anor. v. Public Prosecutor [1966] 1 MLJ 229 ***(cit)***
Rex v. Low Toh Cheng [1941] 10 MLJ (SSR) 1 ***(cit)***
Sultan Mohamed v. Regina [1952] 18 MLJ 187 ***(cit)***

Legislation referred to:
Trade Descriptions Act, 1972, ss. 3(1)(b), 16(1)
Trade Marks Act 1976, s. 19(1)

For the Public Prosecutor - Azman Abdullah, DPP
For the respondent - CY Ong; M/s. Ong & Ong

JUDGMENT

This was an appeal by the Public Prosecutor against the acquittal of the respondent at the close of the prosecution's case without calling for his defence under the following charge:

> Bahawa kamu pada 16 Mei 1991 lebih kurang jam 4.00 petang di premis Star Trading, Lot No. 1277, Jalan Tun Fatimah, Kangkar Tebrau di dalam daerah Johor Bahru, di dalam Negeri Johor Darul Ta'zim di dalam perjalanan perdagangan telah menawar untuk membekalkan 792 unit steel wool jenama 'Singa' @ 35 g baginya suatu perihal dagangan palsu iaitu warna dan corak steel wool tersebut yang menyerupai steel wool jenama 'Double Axe' keluaran perusahaan kertas Mei Wah No: 2717 Pantai Kundur, 76400 Tanjung Kling, Melaka telah digunakan dan dengan itu kamu telah melakukan satu kesalahan di bawah s. 3 (1) (b) Akta Perihal Dagangan 1972 dan boleh dihukum di bawah s. 18 (1) Akta yang sama.

At the close of the prosecution's case, the learned Magistrate heard oral submission by the learned Counsel for the respondent, one Mr. CY Ong, but refused to allow the Prosecuting Officer to make any submission. The appeal record at page 33 bears this legend "Mahkamah tidak perlu dengar hujah Prosecuting Officer". Encik Azman bin Abdullah, the learned Deputy Public Prosecutor, took a cudgel and argued quite correctly that the learned Magistrate took a perilous course in not allowing the Prosecuting Officer to submit at the end of the prosecution's case. Seah J. (as be then was) in *Public Prosecutor v. Ong Khoon Seng* [1982] 1 MLJ 351 observed in trenchant terms that:

> Although there is no express provision in the Criminal Procedure Code permitting a defence Counsel to make a submission of no case to answer or for the trial Court to hear such a submission at the close of the prosecution case, the practice of the Courts in this country has always been to allow defence Counsel to make such a submission if he so desires and for the trial Court to permit the Deputy Public Prosecutor to reply to such a submission. It should be remembered that both defence Counsel and the Deputy Public Prosecutor are officers of the Court and they are to assist the Court. In this connection, I would like to refer to the case of *Mahinder Singh v. Public Prosecutor* [1941] MLJ 230 where Terrell Ag. CJ said:
>
> ... The eighth ground of appeal alleges that the accused's Counsel was never given an opportunity of addressing the Court at the close of the case. This is admitted by the learned Deputy Public Prosecutor and constitutes a serious irregularity. In view of this there is no necessity to enter into the merits of the conviction. The appeal will be allowed, the conviction set aside and a new trial ordered.

I see no reason to depart from the observations of Seah J in that case and, on this technical ground alone, I would order a re-trial before another Magistrate. Be that as it may, the crucial point for determination is in regard to the infringement by the respondent in the course of offering to supply 792 units of steel wool bearing the picture of a *'Lion'* as a trade mark on an identical label design in the same colour and design get up as that of Perusahaan Kertas Mei Wah, Pantai Kundor, Tanjong Kling, Melaka which bore the picture of a *"Double Axe"* and which were being sold and passed off as a product of perusahaan kertas Mei Wah. The learned Magistrate took the easy way out by just comparing the picture of the *'Lion'* and the picture of the *"Double Axe"* and ruled that they were dissimilar and, consequently, ruled that the respondent did not contravene s. 3(1)(b) of the Trade Descriptions Act, 1972 ('Act'). Mr. CY Ong argued that the learned Magistrate was correct and cited *Khoo Hi Chiang v. Public Prosecutor* [1994] 1 AMR 6:323 for the proposition that a maximum evaluation of the prosecution evidence was undertaken by the learned Magistrate to determine whether or not the prosecution had established the charge against the respondent beyond all reasonable doubt and urged this Court not to disturb the decision of the learned Magistrate. Section 3(1)(b) of the Act reads as follows:

> (1) Any person who, in the course of a trade or business:
>
> (a) ...
>
> (b) supplies or offers to supply any goods to which a false trade description is applied, shall be guilty of an offence.

In construing s. 3(1)(b) of the Act, one must not lose sight of the deeming provision in s. 8 of the same Act which reads as follows:

> A person exposing goods for supply or having goods in his possession for supply shall be deemed to offer or supply them.

Here, the complainant on a surprise check at the respondent's business premise saw 792 units of steel wool with the *"Lion"* trade mark resembling in terms of colour and design with that of the *"Double Axe"* trade mark and the complainant wasted no time in confiscating those goods and hauled up the respondent, so to speak, to Court. By exposing those goods in that manner, the respondent shall be deemed to offer or supply them to the members of the public and this is the very essence of the charge against the respondent. Way back in 1987, to be precise on 18 April 1987, the Perusahaan Kertas Mei Wah through their solicitors wrote a warning letter to the respondent, who operated his business at the Star Trading Co., Lot 1277, Jalan Tun Fatimah, Kangkar Tebrau, Pandan 81100 Johor Bahru, in the following terms:

ATF/1561/87/FB
18th April 1987

Star Trading Co.
Lot: 1277, Jalan Tun Fatimah,
Kangkar Tebrau, Pandan,
81100 Johore Bahru.

Dear Sirs,

Re: Trade Mark "Double Axe" under T.M. Registration No: M/89941 in class 21 in respect of steel wool - Perusahaan Kertas Mei Wah.

We act for Perusahaan Kertas Mei Wah of No: 2717, Pantai Kundor, Tanjong Kling, Malacca who are the registered proprietors of the Trade Mark "Double Axe" under trade mark registration no: M/89941 in class 21 in respect of steel wool. The said trade mark is limited to the colours red, green and black.

It has come to our clients' attention that you have been selling steel wool in a package which is similar to our clients' registered trade mark and accompanying get up with the intention of deceiving the general public.

Take Notice that warning notices have already been published in the English and Chinese newspapers of our client's interests in the said trade mark and photocopies of the said advertisements are enclosed for your attention.

Further Take Notice that if you do not forthwith cease and desist from selling steel wool in packages which are similar to our client's trade mark and accompanying get up, our client shall apply to the High Court to obtain a Trade Description Order against you and further take all other necessary legal proceedings against you to recover damages against you.

Yours faithfully,

(Illegible)
Sgd

c.c Clients.

It had been established through exhibits P16 (a) and (b) that warning notices were published in the English and Chinese newspapers and the English version of that warning notice was worded in the following fashion:

Warning Notice

Notice is hereby given that Perusahaan Kertas Mei Wah of No: 2717, Pantai Kundor, Tanjong Kling, Malacca is the registered proprietor in Malaya of the Trade Mark "DOUBLE AXE" shown above (which is limited to the colour red, green & black) under Registration No: M/89941 in class 21 in respect of steel wool.

It has come to the attention of Perusahaan Kertas Mei Wah that steel wool bearing a mark and get-up identical to or resembling its registered Trade Mark

and accompanying get-up have been sold by persons not authorised by Perusahaan Kertas Mei Wah.

Take Notice that all steps will be taken to commence immediate legal proceedings against any person, firm or company found infringing Perusahaan Kertas Mei Wah's rights in the said Trade Mark by sale or offering for sale steel wool bearing the said Trade Mark or get-up identical to the said Trade Mark or any colourable imitation thereof.

Amir Toh Francis & Partners,
6.02, 6th Floor, Wisma M.C.A.,
Jalan Ampang, 50450 Kuala Lumpur.
Solicitors for Perusahaan Kertas Mei Wah.

Perusahaan Kertas Mei Wah of No: 2717, Pantai Kundor, Tanjong Kling, Malacca did not mince words and on 10 September 1988 they obtained a trade description order before Wan Yahya bin Pawan Teh J (now FCJ) at the Malacca High Court. That trade description order was obtained in pursuance of s. 16 (1) of the Act and was worded thus:

In the High Court of Malaya at Malacca

Originating Motion No: 32-18 of 1987

In the Matter of Perusahaan Kertas Mei Wah.

And

In the matter of s. 16 (1) of the Trade Descriptions Act, 1972.

And

In the matter of a trademark consisting of the words **Double Axe** and accompanying device more specifically represented in the Schedule hereto.

Teo Chwee Bock
(t/a Perusahaan Kertas
Mei Wah). ... Applicant

Before the Honourable Justice Dato Wan Yahya bin Pawan Teh

This 10th day of September 1988

In Open Court

Order

Upon Motion made unto this Court pursuant to *Ex-parte* Notice of Originating Motion **And Upon Reading** the said *Ex-parte* Notice of Originating Motion dated the 2nd day of November, 1987 and the affidavits of Teo Chwee Bock affirmed on the 30th day of October, 1987; on the 13th day of April, 1988 and on the 30th day of August, 1988 and filed herein **And Upon Hearing** Mr. Anselm Fernandis of Counsel for the applicant **It Is Ordered** as follows:

(1) That the manufacture, import, sales, distribution or supply by any unauthorised persons of steel wool bearing the trademark consisting of the words **Double Axe** and a device as is more specifically represented in the Schedule hereto or any other word or device mark which is of phonetic or colourable resemblance thereto be deemed a false trade description within the Trade Descriptions Act 1972;

(2) That the use by persons who are not the licensed or permitted users of the said trademark consisting of the words **Double Axe** and accompanying device as is more specifically represented in the Schedule hereto or any other word or device mark which is of phonetic or colourable resemblance thereto in connection and in association with steel wool be deemed a false trade description within the meaning of the Trade Descriptions Act 1972;

(3) That the costs of this application be paid by the applicant in any event.

Dated this 10th day of September, 1988

Sgd.
Senior Assistant Registrar
High Court, Malaya,
Malacca.

This Order is filed by Messrs. Amir Toh Francis & Partners of Suite 6.02, 6th Floor, Wisma MCA, 163, Jalan Ampang, 50450 Kuala Lumpur, Solicitors for the applicant.

(P.C. 25)

It is interesting to note that by exhibit (P7) the *"Double Axe"* trade mark was registered under s. 19 (1) of the Trade Marks Act, 1976 (Act 175) in exactly the same colour scheme as that exhibited in the schedule of the trade description order. In all its splendour, the *"Double Axe"* trade mark had attractive colours of red, green and black in stripes. By exhibit "DID 11", the *"Lion"* trade mark was also registered but its registration showed a solitary *"Lion"* without the frills - in sharp contrast to the *"Double Axe"* trade mark as reflected in exhibit P7. But the end product of the *"Lion"* trade mark as shown in exhibit P5 clearly differ from what was registered in exhibit "DID 11". In exhibit P5 except for the *"Lion"* trade mark, the name of the company where the product was manufactured, the words *"Cap Singa"* and the price at 40 cents appearing therein, the rest of the particulars particularly the colour schemes and designs were exactly the same as that of the *"Double Axe"* trade mark. In P5 too there was no Jawi script written therein. The general public on seeing both the *"Double Axe"* and *"Lion"* trade marks with similarities in colours and designs would certainly be deceived into believing that the *"Lion"* trade mark was in fact that of the *"Double Axe"* trade mark. In short, the *"Lion"* trade mark could pass off as the *"Double Axe"* trade mark.

Siti Norma Yaacob J (now JCA) in *Tan Hap @ Tan Hwa Ho & Anor. (both t/a Syarikat Kwong Hock Hin) v. Liang Ann Hock t/a Kim Guan Trading Company* [1989] 2 CLJ 500 in setting aside the *ex-parte* trade description order dated 11 May 1987 with costs set out the comparison test in the following words:

> It is the respondent's submission that its trade mark does not resemble the applicants' trade mark and for this relies on the comparison test for which three rules have been adhered to:
>
> (1) The marks concerned must be considered as a whole as the true test on the totality of impression given both orally and visually is such as to cause mistake, deception or confusion - *Re Bailey's Application* (1953) 52 RPC 136; *Broadhead's Application* (1950) 67 RPC 113 and *Saville Perfumery v. June Perfect* [1941] 58 RPC 149.
>
> (2) In comparing two trade marks, it must also be considered whether the marks suggest the same idea or lead to the goods being referred to by the same name.
>
> (3) Where words of two trade marks are compared, they must be Judged by their looks and sound. In *re Application by Pianotist Company Ltd.* [1906] 23 RPC 774; *Kidax's* case [1959] RPC 295.

On facts, the present appeal are poles apart from *Tan Hap @ Tan Hwa Ho & Anor. (both t/a Syarikat Kwong Hock Hin) v. Liang Ann Hock t/a Kim Guan Trading Company (supra).* Here, the solitary *"Lion"* trade mark as registered and reflected in "DID 11" are totally different from the end product as set out in exhibit P5. When one compares "DID 11" with the *"Double Axe"* trade mark, a marked difference can be discerned. And when one compares exhibit P5 with the *"Double Axe"* trade mark and, at the same time, bearing in mind "DID 11", one will definitely conclude that it would cause "mistake, deception or confusion" - to borrow the words of Siti Norma Yaacob J (now JCA) in *Tan Hap @ Tan Hwa Ho & Anor (both t/a Syarikat Kwong Hin) v. Liang Ann Hock t/a Kim Guan Trading Company (supra),* to the general public.

It would not be incorrect to say that the respondent must have recognised that it was to their commercial advantage to be able to use the same get up for their goods as that which had been associated with that of Perusahaan Kertas Mei Wah, and indirectly, attracting to themselves some of the Perusahaan Kertas Mei Wah's goodwill and reputation (*F. Hoffman-La Roche Company A.G. And Another v. DD SA Pharmaceuticals Limited* [1972] RPC page 1). In the Malaysian context, rural housewives will be easily deceived. The same colour schemes for both the *"Lion"* and the *"Double Axe"* trade marks would certainly fool rural housewives to opt for the *"Lion"* trademark products. The Registrar of Trade Marks would certainly not register a trade mark when it resembles or is likely to deceive or cause confusion

(see s. 19(1) of the Trade Marks Act, 1976 (Act 175)). Had the respondent registered (P5) which to all intents and purposes bore colourable resemblance to the *"Axe Brand"* trade mark, I am certain that it would be rejected by the Registrar of Trade Marks. All these salient facts and features of the whole scenario to the present appeal were overlooked by the learned Magistrate. In my judgment, the learned Magistrate gravely erred in not highlighting certain salient features of the present appeal as adumbrated above but instead wrote a sketchy judgment which was patently inadequate (*Balasingham v. Public Prosecutor* [1959] 25 MLJ 193; *Augustine v. Public Prosecutor* [1964] 30 MLJ 7; *Hashim & Anor. v. Public Prosecutor* [1966] 1 MLJ 229; *Rex v. Low Toh Cheng* [1941] 10 MLJ (SSR) 1; and *Sultan Mohamed v. Regina* [1952] 18 MLJ 187).

For the foregoing reasons, the appeal was allowed. The order of acquittal was reversed and the respondent was ordered to be re-tried before another Magistrate. An ancillary order was also made to the effect that the case be mentioned before another Magistrate by 3.00 p.m. today.

Reported by W.A. Sharif